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Paper No. 21  
Bottorff

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kendro Laboratory Products GmbH

Serial No. 75/435,249

John H. Weber of Baker & Hostetler, LLP for Kendro Laboratory Products GmbH.

Anne M. Farrell, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Hairston and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark CYTOMAT (in slightly stylized, lower-case letters) for goods identified in the application as "incubators for laboratory purposes" in Class 9 and

"temperature and climatic cabinets for general industrial applications" in Class 11.<sup>1</sup>

The Trademark Examining Attorney has issued a final refusal of registration, on the ground that applicant's mark, as applied to applicant's goods, so resembles the mark CITOMAT, previously registered (in typed form) for goods identified in the registration as "autoclaves" (in Class 11),<sup>2</sup> as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant has appealed the final refusal. The appeal is fully briefed, but no oral hearing was requested. We affirm the refusal to register.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these

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<sup>1</sup> Serial No. 75/435,249, filed February 17, 1998. The application was filed pursuant to Section 44(d); applicant later submitted a certified copy of its German Registration No. 397 54 456.

<sup>2</sup> Registration No. 2,223,010, issued February 9, 1999. The registrant is Getinge Skarhamn Aktiebolag, a Swedish corporation. The registration is use-based.

factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we turn to a determination of whether applicant's mark and the cited registered mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find that the marks are similar in terms of appearance, differing only by one letter. The stylization of applicant's mark (in all lower case letters) is minimal and does not distinguish the marks visually, especially in

view of the fact that the cited mark is registered in typed form and thus might appear in all reasonable stylizations, including in all lower case letters. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983).

We also find that the marks are similar, indeed, legally identical, in terms of sound. Applicant argues that the marks are not phonetically identical because the first syllable of its CYTOMAT mark is pronounced with a long "i" sound, while the "rules and conventions" of English pronunciation "dictate" that the "i" in the first syllable of the registered CITOMAT mark would be pronounced as a short "i," as in the words "citizen" and "citrus." We are not persuaded. Although an "i" following a soft "c" often is pronounced as a short "i," as in the examples cited by applicant, applicant has identified no pronunciation rule or convention which requires that result. Indeed, common words such as "citation," "cipher," "cider," and "decide" belie the existence of any such rule or convention. Thus, because the registered CITOMAT mark reasonably might be pronounced with a long "i" sound in the first syllable, it is legally identical to applicant's CYTOMAT mark in terms of sound.

Moreover, even assuming *arguendo* the validity of applicant's premises, i.e., that an apparently coined mark like CITOMAT has a "correct" pronunciation, and that, as applicant contends, in such "correct" pronunciation the "i" in the first syllable of the mark is a short "i" and not a long "i", it is settled that "correct" pronunciation cannot be relied on to avoid a finding of likelihood of confusion. See, e.g., *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461 (TTAB 1985); see also TMEP §1207.01(b)(iv) and cases cited therein. Furthermore, and again assuming that applicant is correct in contending that the marks, as "correctly" pronounced, are not phonetically identical due to the different vowel sounds in the first syllable of each mark, we nonetheless find that the marks are phonetically similar, for purposes of the first *du Pont* factor. That is, any dissimilarity between the marks which results from a slight difference in their first syllable vowel sounds is outweighed by the overall similarity which results from the fact that the marks otherwise sound identical in all respects.<sup>3</sup>

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<sup>3</sup> Citing *Pan American Life Insurance Co. v. Federated Mutual Insurance Co.*, 226 USPQ 914 (TTAB 1985), applicant argues that even if we find that applicant's mark and the cited registered mark are phonetically identical or similar, that fact is not dispositive and should be accorded little weight in our analysis because the goods involved in this case are not marketed principally or solely by means of verbal communication of the

In terms of connotation and commercial impression, we find that neither of the marks, when viewed in its entirety, has any apparent or concrete meaning. That is, there is no indication in the record that CYTOMAT, as a whole, means anything in particular; the same is true for CITOMAT. Likewise, there is no evidence as to the meaning, if any, of the MAT portion of either of the marks.

Applicant argues, however, that the prefixes CYTO- and CITO- have different meanings which give the respective marks different commercial impressions. Specifically, applicant asserts (and we agree) that the prefix CYTO- in its mark would be understood to refer to "cytology," the study of cells, and that applicant's mark therefore suggests to potential purchasers that applicant's goods have something to do with cells or the study of cells. Applicant next argues that the prefix CITO- in the

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marks, e.g., by telephone solicitation or word-of-mouth recommendation. However, the evidence of record does not establish that the marketing of these goods would not or could not involve such verbal communication of the marks. In any event, we are not persuaded that *Pan American Life Insurance* stands for the proposition for which applicant apparently cites it, i.e., that phonetic similarity between the marks is entitled to significant probative weight only if the involved goods or services are of a type which are marketed solely or primarily via verbal communication of the marks. Even if the phonetic similarity between the marks is not dispositive, as applicant argues, we reject applicant's contention that we should accord the phonetic similarity any diminished probative weight.

registered mark is a foreign word meaning "fast" or "quick," and that, according to the doctrine of foreign equivalents, purchasers would understand the registered mark to refer to the fast or quick nature of registrant's autoclaves. Applicant further contends that even if the registered mark does not have this particular connotation for purchasers, neither does it have the "cytology" connotation of applicant's mark.

Assuming *arguendo* that applicant is correct in its contention that CITO- in the registered mark is derived from the foreign word "cito,"<sup>4</sup> we nonetheless agree with the Trademark Examining Attorney that such foreign meaning of "cito" is too obscure and unknown to American purchasers to have any significant effect on the commercial impression

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<sup>4</sup> In support of its contention regarding the meaning of CITO- in the cited registered mark, applicant has submitted a printout of a third-party registration (of the mark CITO for goods identified as "creasing or makeready strips for cutting and embossing machines") which includes the following translation statement: "The English translation of the word 'CITO' in the mark is "fast or quick." However, an *ex parte* translation statement in a registration or application is not conclusive evidence of the meaning of the term in question. See *Bottega Veneta, Inc. v. Volume Shoe Corporation et al.*, 226 USPQ 964, 966 at n.4 (TTAB 1985). We take judicial notice that "cito" is a Latin adverb meaning "quickly, soon." See The Bantam New College Latin & English Dictionary (2d ed. 1995). Although this dictionary evidence appears to corroborate the accuracy of the translation statement in the third-party registration with respect to the meaning of the word CITO as it is used in the registered third-party mark, it does not prove that the term has the same meaning, or any meaning, in the registered mark CITOMAT. However, as noted above, we shall assume *arguendo* that applicant's suggested connotation of the cited registered mark is correct.

created by the cited registered mark. See, e.g., *Jules Berman & Associates, Inc. v. Consolidated Distilled Products, Inc.*, 202 USPQ 67 (TTAB 1979)(CHULA confusingly similar to KAHLUA in terms of appearance and sound; similarity not overcome by fact that CHULA has a meaning in Spanish ("pretty") which the arbitrary term KAHLUA does not, because that Spanish meaning would unknown to American purchasers).<sup>5</sup> Rather, as noted above, we find that purchasers are likely to view CITOMAT as an arbitrary or coined mark with no apparent meaning. It certainly has no readily apparent meaning which would directly aid purchasers in distinguishing it from applicant's otherwise similar mark.

Applicant's reliance on the doctrine of foreign equivalents is entirely misplaced. In the context of Section 2(d), the doctrine operates to preclude registration of a foreign term when its English equivalent has already been registered for similar goods or services,

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<sup>5</sup> The Board's rationale in *Jules Berman*, i.e., that the Spanish word "chula" is too obscure to American purchasers to affect the commercial impression of the mark or to distinguish it from a mark to which it is otherwise similar, applies *a fortiori* to the Latin word "cito" in the present case.

or vice versa.<sup>6</sup> Such is not the situation here; applicant is not seeking to register the English equivalent of a previously-registered foreign term or the foreign equivalent of a previously-registered English term, nor is any such foreign equivalence the basis of the Trademark Examining Attorney's Section 2(d) refusal. The foreign equivalence, *vel non*, of applicant's and registrant's marks is not at issue here, and the doctrine of foreign equivalents therefore is wholly inapposite. Rather, and as discussed above, we find that the possible Latin significance of CITO- in registrant's mark is too obscure to affect the mark's commercial impression, or to have any significant effect on our comparison of the marks under the first *du Pont* factor. See *Jules Berman & Assoc., Inc. v. Consolidated Distilled Products, Inc., supra*.

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<sup>6</sup> As McCarthy notes:

The doctrine of foreign equivalents is not an absolute rule, for it does not mean that words from dead or obscure languages are to be literally translated into English for any and all trademark comparison purposes. The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent. The rationale of this rule is that a foreign word familiar to an appreciable segment of American purchasers may be confusingly similar to its English equivalent, or vice versa.

J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §23:36 (4<sup>th</sup> ed. 6/2000).

In summary, we find that applicant's mark and the cited registered mark are highly similar in terms of appearance, and that they are legally identical or at least highly similar in terms of sound. Given these points of similarity between the marks, and given the fallible recollections of purchasers, we cannot conclude that the connotations and overall commercial impressions of the marks are so different that confusion is unlikely to result from use of the marks on similar or related goods. We find that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.<sup>7</sup>

We next turn to a consideration, under the second *du Pont* factor, of the similarity or dissimilarity of the goods identified in applicant's application ("incubators for laboratory purposes" and "temperature and climatic cabinets for general industrial applications") and the

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<sup>7</sup> We are not persuaded by the Trademark Examining Attorney's argument that the "unsolicited online alternate suggested search" she received from the Google Internet search engine is probative evidence that applicant's mark and the cited registered mark create the same commercial impression, and we have not relied on that evidence in reaching our conclusion under the first *du Pont* factor. There is no evidence as to how or why this "alternate suggested search" was generated by Google, nor any evidence as to the significance (trademark or otherwise) purchasers would attach to the suggestion, if any.

goods identified in the cited registration ("autoclaves").<sup>8</sup> It is not necessary that the respective goods or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978). Moreover, the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support

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<sup>8</sup> We take judicial notice that "autoclave" is defined as "an apparatus (as for sterilizing) using superheated steam under pressure." Webster's Ninth New Collegiate Dictionary (1990) at 117.

a finding of likelihood of confusion. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

We find that applicant's goods, as identified in the application, are sufficiently related to registrant's goods, as identified in the cited registration, that confusion is likely to result from the use thereon of the similar marks involved in this case. The evidence of record includes printouts of two third-party registrations (Reg. Nos. 2,220,060 and 2,519,602) which include in their respective identifications of goods both the type of goods identified in applicant's application and the type of goods identified in the cited registration.<sup>9</sup> Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the

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<sup>9</sup> We agree with applicant's contention that the printouts of third-party pending applications submitted by the Trademark Examining Attorney are of no probative value. We likewise agree that the probative value of the other third-party registrations submitted by the Trademark Examining Attorney is lessened considerably to the extent that they cover goods or services not involved in this case, to the extent that they are for house marks and/or cover too wide a variety of goods, and to the extent that they do not cover "autoclaves." As to this last point, we cannot determine that the Class 11 "sterilizers" identified in several of the third-party registrations (Reg. Nos. 1,333,007, 948,922, 694,889 and 656,420) necessarily are, or encompass, "autoclaves."

extent that they suggest that the goods or services identified therein are of a type which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988). We find that this evidence, although not overwhelming in terms of quantity, suffices to establish the requisite relationship between applicant's and registrant's respective goods, under the second *du Pont* factor.

Under the third *du Pont* factor, we find that the parties' respective goods are of types which normally are sold in and to the same or overlapping trade channels and purchasers, i.e., to laboratories. Applicant argues that its goods and registrant's goods, as actually and currently marketed, are used by laboratories working in different fields or for different applications. However, no such limitations or restrictions appear in applicant's or registrant's respective identifications of goods, and they therefore can be given no consideration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (F2d. Cir. 1987); *In re Elbaum*, 211 USPQ 639

(TTAB 1981). This factor also weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor, there is no evidence as to the cost of the goods involved in this case, but we assume that they are purchased with some degree of care. However, we cannot conclude on this record that purchasers of these goods are so sophisticated and careful that they necessarily would be immune to source confusion arising from the use of these highly similar marks. This *du Pont* factor weighs in applicant's favor, but only slightly.

Applicant has presented the affidavit of one of its officers, attesting to thirty-two months of contemporaneous use of the respective marks in commerce without any actual confusion. We have considered this evidence but find that it is entitled to little probative weight. Although, as discussed above, there is a legal presumption that the respective goods as identified in the application and registration are marketed in the same trade channels and to the same classes of purchasers, there is no evidence that applicant's and registrant's actual goods have been marketed in the same trade channels or to the same classes of purchasers. Indeed, applicant asserts that the actual trade channels and classes of purchasers have not overlapped. In such circumstances, there is no basis for

concluding that there has been any meaningful opportunity for actual confusion to have occurred, such that the absence of actual confusion is factually surprising or legally significant. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

We have considered all of the evidence of record pertaining to the *du Pont* evidentiary factors, and we conclude that a likelihood of confusion exists. The marks are highly similar. There is no evidence (under the sixth *du Pont* factor) of any use of similar marks on similar goods which might narrow the scope of protection to be afforded the cited registered mark. The goods identified in the application and the cited registration are of types which may emanate from a single source under a single mark, and they must be presumed to be marketed in the same trade channels and to the same classes of purchasers. In our likelihood of confusion analysis, we conclude that the evidence on these factors outweighs the evidence on other factors (i.e., sophistication of purchasers and absence of actual confusion) which might weigh in applicant's favor.

We have carefully considered applicant's arguments to the contrary, including any arguments not specifically discussed in this opinion, but are not persuaded of a different result. To the extent that we have any doubt as

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to the existence of a likelihood of confusion, we must resolve that doubt against applicant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register is affirmed.